

REMARKS

I. Status of the Application.

Claims 1-19 were filed with this application. In a non-final office action dated July 24, 2008, Examiner Greece (a) rejected claims 1-8 under 35 U.S.C. 102 as being obvious over U.S. Patent Publication 2004/0054358 to Cox et al. (the "Cox Reference"); (b) rejected claims 9-19 as being unpatentable over the Cox Reference in further light of U.S. Patent 5,777,719 to Williams et al. (the "Williams Patent"); and (c) rejected claims 8 and 15 for lack of antecedent basis. In this response, Applicants (a) amend claims 1 and 9 to clarify that the method employs quadratic fitting to identify spherocylinder refraction, contrary to the cited references, (b) respectfully traverse the examiner's rejections; and (c) amend claims 8 and 15.

II. Overview of the Cox Reference and the Williams Patent

Both the Cox Reference and the Williams Patent disclose an a method for which aberration data is collected and then used to provide a high order aberration correction for the eye with either refractive surgery, contact lenses, or intraocular lenses, and not for spectacle lenses. (Williams Patent, Col. 2, Ins. 43-45, "a primary object of the present invention to provide a method of and an apparatus for accurately measuring higher order aberrations of the eye and for using the data thus measured to compensate for those aberrations with a customized optical element;" Cox Reference, para 0043, "a customized LASIK treatment to correct lower-order and higher-order aberrations that cause vision defects in the patients eye 120, or a custom treatment for a decentered ablation will apply to PRK and LASEK, for example, as well as to the design and performance of custom ophthalmic optics including contact lenses, IOL's, inlays, and onlays.") As such, the Williams Patent and Cox Reference employ new refractive surgery and lens fabrication methods to develop lenses and corneas that will correct other than

the typical lower order spherocylinder errors, contrary to the claimed method. Therefore, the cited references do not disclose a method for optimizing a low order correction for spectacle lenses that eliminates the need for subjective refractions.

In addition, the cited references do not eliminate the need for subjective refractions to conduct low order optimizations. The Cox Reference goes on to admit that "the practitioner may want to optimize post-surgical spherical (and others) aberration," indicating that low order aberration correction are not necessarily optimized through the method. *Id.* Further, the cited references do not disclose any methods for creating a prescription for spectacle lenses using this method, only refractive surgery, contact lenses, and intraocular lenses, and the Cox Reference employs subjective refractions, a process that is eliminated through the use of the method claimed herein. (Cox Reference, para 120, "a diagnostic station 210 preferably incorporates and aberrometer for wavefront measurement, and may also include any suitable diagnostic instrumentation 212 as shown, for example, a topography device for measuring corneal geometry, and autorefractor or other device for objective or subjective refraction data The information is still further modified at 259 by personalized surgeon monogram 260.")

III. Claims 1-8 As Amended are Not Anticipated by the Cox Reference

A. Standard for Anticipation

In order to establish that the claims are anticipated by the Cox Reference, the reference must teach every element of the claim. MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Indeed, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d

1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added. Therefore, without enabling disclosure of each and every element or limitation of a claim, a *prima facie* case of anticipation cannot be made against a claim.

B. Claim 1 Has Been Amended to Emphasize Lack of Anticipation

Applicants have amended claim 1 to emphasize that the claims are directed to "A method for optimizing a refractive spectacle lens prescription without using subjective refractions," further including the limitation that method employs "the equivalent quadratic fitting calculation to obtain at least one clinical refractive spherocylindrical prescription" Since the Cox reference does not disclose optimizing spectacle lenses, nor does it disclose the optimization of lower order prescriptions without the use of subjective refractions as discussed in detail in Section II above, Applicants respectfully request reconsideration and allowance of the claim as amended. Further, since claims 2-8 depend from claim 1, allowance of those claims is respectfully requested.

IV. Claims 9-19 are Not Obvious in Light of the Cox Reference or the Williams Patent

A. Standard for Obviousness

MPEP § 2142 states that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." A *prima facie* case of obviousness requires that "an apparent reason to combine the known elements in the fashion claimed . . . should be made explicit," a reasonable likelihood of success in modifying the prior art, and the cited references must contain all of the limitations of the claims. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007); MPEP §2143. Therefore, in order for references to render the claims obvious, (1) the cited references must include each and every limitation within

the claim cited; (2) the examiner must explicitly point to a particular reason to combine or modify the one or more references; and (3) there must be a reasonable basis to believe that the modifications or combination of the cited references would be successful. For the reasons cited below, Applicants respectfully submit that the amended claims are not subject to a *prima facie* conclusion of obviousness.

B. Claim 9 Has Been Amended to Emphasize Lack of Obviousness

Applicants have amended claim 9 to emphasize that the claims are directed to "A method for optimizing a refractive spectacle lens prescription without using subjective refractions." Since neither the Cox Reference nor the Williams Patent disclose optimizing spectacle lenses, nor does it disclose the optimization of lower order prescriptions without the use of subjective refractions as discussed in detail in Section II above, Applicants respectfully request reconsideration and allowance of the claim as amended. Further, since claims 9-19 depend from claim 9, Applicants respectfully request allowance of those claims.

V. Claims 8 and 15 Have Been Amended

Applicants have amended claims 8 and 15 to properly include antecedent basis for the term "the environmental data." Applicants respectfully request reconsideration of the rejection in light of this amendment.

CONCLUSION

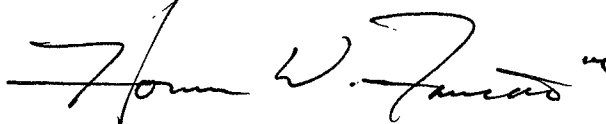
For all the foregoing reasons, it is respectfully submitted that Applicants have made a patentable contribution to the art and that this response places all of the pending claims of the

above identified application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested.

In the event the Applicants have inadvertently overlooked the need for an extension of time or payment of an additional fee, the Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007.

Sincerely,

ICE MILLER LLP

A handwritten signature in black ink, appearing to read "Homer W. Faucett, III", with a stylized flourish at the end.

Homer W. Faucett, III

Attorney Registration No. 59,346

ICE MILLER LLP

One American Square, Suite 2900

Indianapolis, Indiana 46282-0002

Telephone: (317) 236-2120

Facsimile: (317) 592-4819

Date: 1/26/09

HWF/pgf

cc: Dr. Bill Brizzard